REMARKS

Claims 1-25 are pending in the present patent application. Claims 1-25 stand rejected. By this amendment, claims 1, 11 and 17 have been amended. This application continues to include claims 1-25.

Applicants thank the Examiner for clarifying certain content in the Final Office Action of January 9, 2004, in the telephone discussion with Applicants' attorney on February 26, 2004.

Claim 1 stands rejected under 35 U.S.C. 102(b) as being anticipated by Cheshire, S., Current Meeting Report, Cheshire, et al., 03/99. Applicants incorporate by reference the prior arguments made in the Response to the Office Action of July 25, 2003,with respect to claim 1.

In summary, in the prior Response, Applicants explained that Applicants' invention as recited in claim 1 utilizes a network connected computer to obtain an IP address for another network connected device, i.e., the computer performs the IP address assignment task for the device, which is separately connected to the network, by assigning an IP address to the network adapter utilized by the device. In other words, the network adapter connecting the device to the network does not engage in "self-assignment" of an IP address, but rather, relies on computer also connected to the network to obtain an IP address for it.

In contrast, in Cheshire, et al., it is stated that "Stuart Cheshire presented a basic overview of IPv4 address self configuration . . . (emphasis added)." In the self configuration process, Cheshire, et al. discloses picking a random address, sending an ARP probe to verify that the address is not already in use, and if the IP address is not in use, configuring the interface with the IP address (see pages 2-3).

In response to Applicants' arguments, in paragraph 8 the Examiner indicated that while noting Applicants' interpretation of the prior art, "(i.e., an interface communicatively couples a device separate from the computer and that the computer obtains an IP address for the network adaptor to permit network communication by the device) are not recited in the claims."

In order to clarify Applicants' intended interpretation of claim 1, Applicants have amended claim 1. Claim 1 recites, among other things, the steps of "providing a computer communicatively coupled to said network" and "providing a network adapter to communicatively couple said device to said network. Claim 1 has been amended to further recite, "said network providing communicative interconnection between said computer and said network adapter". Further, claim 1, as amended, recites that *the computer performs*, among other things, the step of "determining whether a response to said address resolution protocol probe indicates that said internet protocol address is in use; wherein if said internet protocol address is not in use, then performing the step of assigning said internet protocol address to said network adapter via said network." (Emphasis added). Thus, claim 1 as amended clearly indicates that the network separates the computer from the network adapter, since it is the network that provides communicative interconnection between the computer and the network adapter. Further, it is the computer that generates an IP address and assigns, via the network, the IP address to the network adapter that couples the device, such as for example, a printer, to the network.

Support for the amendment to claim 1 may be found, for example, in Applicants' Fig. 1 (showing computer 12, network 16, and a networked device 14 including a network adapter 24) and in the Specification at page 3, lines 20-28,

wherein it is stated that, "Networked device 14 includes printer firmware 22 and a low-cost network adapter (LCNA) 24, which are communicatively interconnected. []. Network 16, such as a LAN, provides communicative interconnection between computer 12 and networked device 14...." (emphasis added), and at page 4, lines 19-21, stating, "IP stack 34 [of computer 12] is used by LCNA host software 30 [of computer 12] to communicate with each LCNA 24 on network 16."

Applicants believe that claim 1, as amended, clearly and patentably defines Applicants' invention over Cheshire, et al., and the other cited references as well. Accordingly, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. 102(b) be withdrawn.

Claims 2-6 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cheshire, et al. in view of Reed, et al., U.S. Patent No. 6,061,739. Applicants incorporate by reference the prior arguments made in the Response with respect to claims 2-6.

In any event, Reed, et al. also is directed to self-assignment of an IP address. For example, Reed et al, discloses that when the device sees N unanswered ARP requests (where N is a preset threshold) in a given length of time, the device adopts the requested network address and responds to the ARP with its hardware address (col. 4, lines 27-30; Fig. 2).

Accordingly, neither Cheshire, et al. nor Reed, et al., taken alone or in combination, disclose, teach, or suggest the invention of claims 2-6 depending from claim 1, as amended.

Accordingly, Applicants respectfully request that the rejection of claims 2-6 under 35 U.S.C. 103(a) be withdrawn.

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Claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over Cheshire, et al. in view of Reed, et al., and in further view of Mellquist (U.S. Patent 6,115,545). The Examiner concedes that Cheshire, et al. and Reed, et al. do not teach determining if the network adapter has a valid internet protocol address. However, the Examiner asserts that Mellquist discloses, at column 3, lines 11-19, determining if the network adapter has a valid internet protocol address. Applicants incorporate by reference the prior arguments made in the Response with respect to claim 7.

In summary, in contrast to determining if the network adapter has a valid internet protocol address, as recited in claim 7, the relied-upon language of Mellquist merely discloses that a required free address in the range of valid addresses must be selected (col. 3, lines 12-14), and that addresses are usually administered by a person who allocates these addresses to entities who require them (col. 3, lines 14-15). However, statements to the effect that an address must be valid, and that addresses are administered by a person who allocates these addresses to entities who require them, does not disclose, teach, or suggest determining if an IP address is valid, let alone determining if the network adapter has a valid internet protocol address, as recited in claim 7.

Accordingly, claim 7 is believed patentable in its own right. In addition, claim 7 is believed patentable due to its dependence from claim 1, as amended.

In view of the above, Applicants respectfully request that that the rejection of claim 7 under 35 U.S.C. 103(a) be withdrawn.

Claims 8-25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cheshire, et al. in view of Reed, et al., in further view of Mellquist, and in further view of Troll, Request for Comments: 2563, May 1999, Troll R. Applicants

incorporate by reference the prior arguments made in the Response with respect to claims 8-25.

With respect to claim 8, the Examiner concedes that Cheshire, et al. in view of Reed, et al., and in further view of Mellquist, do not disclose the subject matter of claim 8, and therefore, relies on Troll. In summary, Troll is directed to allowing a DHCP client to determine whether it should <u>assign itself</u> an address (page 2) using an auto-configure option (page 3). In addition, each of Cheshire, et al., Reed, et al. and Mellquist are also directed to self-assignment.

Accordingly, claim 8 is believed allowable in its own right. In addition, claim 8 is believed allowable in view of its dependence from otherwise allowable intervening claim 7 and/or base claim 1, as amended. Applicants thus respectfully request that the rejection of claim 8 under 35 U.S.C. 103(a) be withdrawn.

Claims 9 and 10 are believed allowable due to their dependence, directly or indirectly, on otherwise allowable base claim 1. As stated above, each of Cheshire, et al., Reed, et al., Mellquist and Troll are directed to self-assignment, and thus, would not render claim 1, nor dependent claims 9 and 10, obvious. Applicants thus respectfully request that the rejection of claims 9 and 10 under 35 U.S.C. 103(a) be withdrawn.

Claim 11 has been amended in substantially the same way as claim 1, so as to clarify that the IP address assigned to the network adapter is assigned to the low-cost network adapter <u>by the separately network connected computer,</u> in contrast to self-assignment of an IP address by the low-cost network adapter. As stated above, each of Cheshire, et al., Reed, et al., Mellquist and Troll are directed to self-assignment, and thus, would not render claim 11 obvious. Furthermore, for substantially the same

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reasons as set forth above with respect to claim 7, the combination of Cheshire, et al. in view of Reed, et al., and in further view of Mellquist, <u>does not</u> disclose, teach, or suggest determining if the low-cost network adapter has a valid internet protocol address, as recited in claim 11.

Applicants respectfully request that the rejection of claim 11 under 35 U.S.C. 103(a) be withdrawn.

Claims 12-16, are believed allowable due to their dependence, directly or indirectly, on otherwise allowable base claim 11, as amended. Accordingly, Applicants respectfully request that the rejection of claims 12-16 under 35 U.S.C. 103(a) be withdrawn.

Claim 17 has been amended in substantially the same manner as claims 1 and 11. For substantially the same reasons as set forth above with respect to claims 1 and 11, Applicants respectfully submit that the cited references, Cheshire, et al. in view of Reed, et al., in further view of Mellquist, and in further view of Troll, taken alone or in combination, do not disclose, teach, or suggest the subject matter of claim 17. For example, Applicants' invention of claim 17, is not directed to self-assignment, but rather, is directed to a method wherein the computer generates and assigns an internet protocol address to a network adapter that is separated by the network from the computer, thus providing an internet protocol address for use by a device, such as a printer, that is distinct from the computer, whereas Cheshire, et al., Reed, et al., Mellquist, and Troll are directed to self-assignment.

Accordingly, Applicants respectfully request that the rejection of claim 17 under 35 U.S.C. 103(a) be withdrawn.

Claims 18-25 are believed allowable due to their dependence, directly or indirectly, on otherwise allowable base claim 17, as amended.

In addition, claim 23 is further believed to be allowable for substantially the same reasons as set forth with respect to claim 7.

Claim 24 is further believed to be allowable for substantially the same reasons as set forth with respect to claim 8.

Accordingly, Applicants respectfully request that the rejection of claims 18-25 under 35 U.S.C. 103(a) be withdrawn.

For the foregoing reasons, Applicants submit that no combination of the cited references teaches, discloses or suggests the subject matter of the appended claims. The appended claims are therefore in condition for allowance, and Applicants respectfully request withdrawal of all rejections and allowance of the claims.

In the event Applicants have overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally petition therefor and authorize that any charges be made to Deposit Account No. 20-0095, TAYLOR & AUST, P.C.

Should any question concerning any of the foregoing arise, the Examiner is

invited to telephone the undersigned at (317) 894-0801.

Respectfully submitted,

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